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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of:

Lawrence E. Williams, III

Serial No.: 09/748,729

Filed: December 26, 2000

For: *Methods and Systems for Providing Life
Management and Enhancement
Applications and Services for Telematics
and Other Electronic Medium*

Confirmation No. 4226

Examiner: Zurita, James H.

Art Unit: 3625

Atty. Docket No. 075000-0276046
NET-001 (CIP)

APPELLANT'S BRIEF ON APPEAL

37 C.F.R. 1.192

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APPEAL BRIEF FEE

37 C.F.R. § 41.20(b)(2)

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By:


Kathleen M. Smith

Appellant's Brief
Ser. No. 09/748,729

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I.
REAL PARTY IN INTEREST
37 C.F.R. 41.37(c)(1)(i)

The real party in interest in this appeal is

☒ the following party: **Roadside Telematics Corporation**

II.
RELATED APPEALS AND INTERFERENCES
37 C.F.R. 41.37(c)(1)(ii)

With respect to other appeals or interferences that will directly affect, or be directly affected by, or have a bearing on the Board's decision in this appeal:

☒ there are no such appeals or interferences.
☐ these are as follows:

III.
STATUS OF CLAIMS
37 C.F.R. 41.37(c)(1)(iii)

Claims 1-33 are cancelled. Claims 34-40 are pending in the application. The Final Office Action objected to Claims 34-40 and rejected Claims 34-40 under 35 U.S.C. § 103. The objections and rejections of claims 34-40 are appealed.

IV.
STATUS OF AMENDMENTS
37 C.F.R. 41.37(c)(1)(iv)

No Amendments were filed under Rule 116.

V.
SUMMARY OF CLAIMED SUBJECT MATTER
37 C.F.R. 41.37(c)(1)(v)

In summary, and with reference to Figure 6, independent Claim 34 provides a method of providing an emergency contact information of a customer using a telematics device 60 embedded in a customer vehicle during an emergency associated with the vehicle. As is known in the art, a

telematics device 60 includes wireless and global positioning systems provided in vehicles or automobiles (Specification at page 3, lines 16-17).

Claim 34 requires accessing the telematics device 60 embedded in the customer vehicle during the emergency associated with the customer vehicle (See, for example, Specification at page 18, line 21 to page 19, line 6).

Claim 34 also requires establishing a communication link between the telematics device 60 and a virtual garage, wherein the virtual garage stores the emergency contact information of the customer (See, for example, Specification at page 10, lines 14-19).

Claim 34 further requires retrieving the emergency contact information from the virtual garage using the telematics device 60 (see, for example, Specification at page 19, line 16 to page 20, line 4).

Claim 34 additionally requires transmitting the emergency contact information to a Public Service Answering Point, wherein the emergency contact information is transmitted from the telematics device 60 to the Public Service Answering point (see, for example, Specification at page 20, lines 5-17).

The independent claim requires, at least, emergency contact information and an embedded telematics device that accesses Applicant's new claims are directed to transmitting and retrieving emergency contact information and expressly excludes medical information.

VI.
GROUND'S OF REJECTION TO BE REVIEWED ON APPEAL
37 C.F.R. 41.37(c)(1)(vi)

- A. Whether the word "emergency" in the term "emergency contact information" renders claims 34-40 indefinite under 35 U.S.C. §112.
- B. Whether claims 34-40 are unpatentable under 35 U.S.C. § 103(a) as being rendered obvious by U.S. Patent No. 6,535,743 to Kennedy et al. ("Kennedy") in view of U.S. Patent No. 6,028,537 to Suman et al. ("Suman") in view of the arguments presented below.
- C. Whether independent claims 34-40 are unpatentable for failing to further limit the independent claim 34.

VII.
ARGUMENT
37 C.F.R. 41.37(c)(1)(vii)

The Examiner objected to claims 34-40 as being indefinite under 35 U.S.C. 112 for failing to point out and distinctly claim the subject matter. The Examiner also objected to claims 37 and 38 under 37 C.F.R. 1.75(c) as being of improper dependent form. The Examiner rejected claims 34-40 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,535,743 to Kennedy III et al. (“Kennedy”) in view of U.S. Patent No. 6,028,537 to Suman et al. (“Suman”) and further in view of “InfoGation Corp. Introduces Productivity, Navigation, Safety and Communication Software Applications for Next-Generation Smart Car System” (“InfoGation”). Of the rejected claims, Claim 34 is an independent claim.

A. Claims 34-40 Adequately Point Out And Distinctly Claim
The Subject Matter Because The Term “Emergency
Contact Information” Is Universally Understood

Independent claim 34 and dependent claims 35-40 are objected to based on an allegation that the term “emergency” as used in “emergency contact information” is indefinite. Applicant disagrees and respectfully submits that one skilled in the art can be readily apprised of the meaning of “emergency contact information” and, further, that “emergency contact information” is used in its plain sense in the claims. The objection to claims 34-40 should be withdrawn for the following reasons:

1. One Skilled In The Art Can Be Readily Apprised Of The
Meaning Of The Term “Emergency Contact Information”

The terms “emergency” and “contact information” are well-defined and one need not be skilled in the art to understand the meaning of “emergency contact information.”

The term “emergency” has an inherently definite meaning that is understood and accepted by those skilled in the art and laymen alike. Emergency is widely understood to mean (1) an unforeseen combination of circumstances or the resulting state that calls for immediate action and (2) an urgent need for assistance or relief (see Merriam-Webster Online Dictionary at <http://www.m-w.com/cgi-bin/dictionary?book=Dictionary&va=emergency>, viewed 4/5/2005).

“Emergency” is often used attributively. *Id.* Hence the term “emergency contact information” is readily understood as contact information for use during an emergency.

“Contact information” is also a term in common use that is well understood by both layman and those skilled in the art. Contact information is information for establishing communications with a person, organization, corporation, etc. A simple Internet search using the term “contact information” yields ample examples of contact information that includes telephone numbers, addresses, Web pages, Email addresses, and so on. Thus, “emergency contact information” is widely understood as contact information for use during an emergency.

Because the term “emergency” is a commonly known and definite term and because its usage in the present application is clearly attributive in connection with the universally understood term “contact information,” the term “emergency contact information” is clearly definite and unambiguous and since it can be easily apprised by a layman, its meaning can be apprised by one skilled in the art.

2. One Skilled In the Art Will Readily Understand The Term “Emergency Contact Information” As Used In The Claims

As discussed in VII.(A)(1) above, the term “emergency contact information” has a definite, easily discernible meaning. However the Office Action contends that various types of emergency contact information may overlap and, the Office Action appears to conclude that emergency contact information necessarily includes medical information. However, this position of the Office Action is only possible if the usage of the word medical in the application and claims is misconstrued.

In the Specification and Claims, the word medical is used exclusively as a qualifier (e.g. “medical log”) to explicitly distinguish between medical emergency contact information and other types of emergency contact information. Specifically, an example is provided in the specification wherein a medical log is described that includes *inter alia* medical emergency contact and history (page 19, line 16 to page 20, line 4). An insurance log including *inter alia* insurance emergency contact and history and an automobile log including *inter alia* vehicle emergency contact and history are also described (page 19, line 16 to page 20, line 4).

Therefore, the specification clearly separates and qualifies contact information associated with vehicle logs, insurance logs and medical logs.

This usage of “medical” as a qualifier does not permit an inference that medical information is included in emergency contact information. The terms “medical emergency contact information” and “medical contact information” are easily distinguished from the term “medical information.” Medical information is information related to, or concerned with physicians or the practice of medicine (Merriam-Webster Online Dictionary at <http://www.m-w.com/cgi-bin/dictionary?book=Dictionary&va=medical>, viewed 4/5/2005). However, “medical contact information” is commonly understood to mean contact information for establishing communications with physicians or practitioners of medicine. In plain terms, medical contact information comprises telephone numbers, addresses, Email addresses and so on, while medical information includes medical histories, descriptions of symptoms, medical procedures, etc. Thus, in the context of the present claims, emergency medical contact information is contact information for establishing communications with physicians or practitioners of medicine during an emergency. Simply put, usage of emergency medical contact information does not involve the practice of medicine, but may involve the use of a telephone. Therefore, the “overlapping ranges of information” announced in the Office Action may result in the intermingling of telephone numbers, but cannot be reasonably said to introduce medical information into emergency contact information.

For at least these reasons, claims 34-40 adequately point out and distinctly claim the subject matter. Accordingly, Applicant respectfully submits that the objections to claims 34-40 should be withdrawn.

B. Claims 34-40 Are Patentable Because The Prior Art Does Not Disclose Or Suggest Retrieving Emergency Contact Information Using A Telematics Device Embedded In A Vehicle During An Emergency Associated With The Vehicle Or Transmitting The Emergency Contact Information To A Public Service Answering Point Using The Telematics Device

Independent claim 34, from which claims 35-40 depend, stand finally rejected under 35 U.S.C. §103(a) as being obvious over Kennedy in view of Suman and further in view of InfoGation. Where a reference fails to expressly or inherently describe each and every element of the claimed invention, rejection is proper only when the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains. See 35 U.S.C. §103(a). The rejection of claims 34-40 should be withdrawn for the following reasons:

**1. Kennedy, Suman, and InfoGation Do Not Render Obvious
Retrieving Emergency Contact Information Using A
Telematics Device Embedded In A Vehicle During An
Emergency Associated With The Vehicle**

Kennedy, Suman, and InfoGation nowhere teach that the emergency contact information of the customer is retrieved from a virtual garage by the telematics device. Instead, the Final Office Action relies on Kennedy at columns 9 and 10 as anticipatory of receiving customer information from a virtual garage. Applicant concedes that the cited passage discusses transfer of data, including uploading and downloading certain data and that these activities may certainly include receiving customer information. However, Kennedy does not teach retrieving emergency contact information as recited in claim 34. Rather than the act of retrieving (i.e. getting and bringing back) of emergency contact information, Kennedy discloses the transfer of data including configuration, menu structures and diagnostic information (see, e.g., Merriam-Webster Online Dictionary, <http://www.m-w.com/cgi-bin/dictionary?book=Dictionary&va=retrieve>, visited 4/5/05). Within the context of claim 34, the reference fails because there is no suggestion of retrieving emergency contact information for transmittal by a telematics device during an emergency associated with a vehicle.

Nor does Kennedy render the retrieving emergency contact information for transmittal by the telematics device. Even where Kennedy treats the subject of emergency situations, Kennedy does not anticipate retrieving the emergency contact information of the customer from the virtual

garage using the telematics device. In Kennedy, a method for indicating the existence of an emergency by activating an emergency assistance button as follows:

In another example, activating emergency assistance button 214 summons medical personnel in the event of a medical emergency, and provides to the appropriate service center 16 relevant medical information about the operator of mobile unit 12. In this regard, mobile unit 12 generates and issues a service message 58 to NSC 14. NSC 14 uses service message 58 to access database 122 and to select an appropriate service center 16 based upon, in one embodiment, the location of mobile unit 12. NSC 14 then provides to the selected service center 16 information such as location, engine data, personal medical data, or any other suitable information on the status or condition of mobile unit 12, or its operator. Service center 16 then establishes a communication session with mobile unit 12 so that it may deliver audible messages or perform other voice communications using voice network 18, to provide emergency and security services to persons or vehicles associated with mobile unit 12. Service center 16 may also provide data services such as remote security services using actuators 28 coupled to mobile unit 12. For example, service center 16 may issue commands to immobilize a vehicle, sound an alarm, lock/unlock doors, or perform any function remotely using an appropriate actuator 28 coupled to mobile unit 12.

(Kennedy at col. 15, lines 7-29).

It is apparent from this latter passage, at best Kennedy proposes transfer of medical information about an operator in response to the activation of an emergency assistance button. More specifically, medical information is transferred from a Kennedy NSC 14 to a service center 16. In contrast, claim 34 of the present application recites that emergency contact information is retrieved using the telematics device and thence transferred to a Public Service Answer Point (see VII.(B)(2), below). Clearly then, the activation of Kennedy's emergency assistance button is akin to a person making a 911 call and does not disclose the telematics device embedded in the vehicle retrieving emergency contact information from the virtual garage and thereafter transmitting the same emergency contact information to the Public Service Answering Point as recited in claim 34.

For at least these reasons, the independent claim 34 patentably defines over Kennedy, Suman, and InfoGation. Accordingly, Applicant respectfully submits that the prior art rejection of claim 34, and claims 35-40 that depend therefrom, should be reversed.

**2. Kennedy, Suman, and InfoGation Do Not Render Obvious
Transmitting The Emergency Contact Information To A
Public Service Answering Point Using The Telematics Device**

As discussed in VII.(B)(1), above, Kennedy, Suman, and InfoGation nowhere teach retrieving the emergency contact information of the customer from the virtual garage using the telematics device as recited in claim 34. It follows, therefore, that the references cannot be said to suggest transmitting emergency contact information of the customer to a Public Service Answering Point from the telematics device embedded in the customer vehicle.

Nevertheless, the Final Office Action appears to rely on Kennedy at column 13, lines 1-19 (transmitting data) and column 5, lines 48-58 (911 service) in suggesting that Kennedy anticipates the recited transmitting the emergency contact information of the customer to a Public Service Answering Point, wherein the emergency contact information is transmitted from the telematics device embedded in the customer vehicle to the Public Service Answering Point of claim 34. Applicants disagree.

However, Kennedy, as cited, describes establishment of a connection to a global computing network such as the Internet, subsequent communications sessions and associated data transfers (col. 13, lines 1-19). This cited passage cannot be said to anticipate or suggest the transmitting of emergency contact information from a telematics device to a Public Service Answering Point as recited in claim 34.

The Office Action then alleges a Public Service Answering Point is anticipated or suggested in Kennedy by citing an overview description of a cellular transceiver 42 call establishment protocol (col. 5, lines 48-58). Specifically, in this passage, the overview description tangentially mentions that a number of retry attempts for calls to a local 911 number may be specified in configuration data 80. Clearly, a number of retry attempts to be made by a transceiver before a call is placed to a local 911 number cannot reasonably be said to anticipate any part of the transmitting of emergency contact information from a telematics device to a

Public Service Answering Point as recited in claim 34. While Kennedy, Suman, and InfoGation may be said to disclose a person making a 911 call, these references cannot be said to render obvious a telematics device embedded in the vehicle transmitting retrieved emergency contact information to a Public Service Answering Point.

Further, Kennedy teaches away from the claimed matter of the present application. Kennedy teaches difficulty in establishing communications with a cellular transceiver (col. 5, lines 48-58). Kennedy explicitly teaches NSC 14 transferring information from NSC 14 to a service center 16 independently of, and prior to establishing a communications link between NSC and mobile unit 12 (see col., lines 19-24). In view of these Kennedy teachings, one skilled in the art would perceive an advantage in transmitting information from a service center rather than from a mobile device that is susceptible to erratic connections. Therefore, Applicant respectfully submits that it is reasonable to conclude that Kennedy teaches away from an embedded telematics device that transmits emergency contact information. This latter conclusion is supported because it is supported by the explicit teachings of Kennedy.

For at least these reasons, the independent claim 34 patentably defines over Kennedy, Suman, and InfoGation. Accordingly, Applicant respectfully submits that the prior art rejection of claim 34, and claims 35-40 that depend therefrom, should be reversed.

C. Claims 37 And 38 Have a Proper Antecedent Basis And Further Limit Independent Claim 34

Dependent claims 37 and 38 stand objected to as improper for failing to further limit the subject matter of claim 34. The objections should be withdrawn for the following reasons:

The term “telematics device” as recited in the dependent claims will be readily understood by one skilled in the art as being equivalent to the “telematics device embedded in a customer vehicle” in the claims as recited in the independent claim. If the scope of a claim would be reasonably ascertainable by those skilled in the art, then the claim is not indefinite. *Ex parte Porter*, 25 USPQ2d 1144, 1145 (Bd. Pat. App. & Inter. 1992) (“controlled stream of fluid” provided reasonable antecedent basis for “the controlled fluid”; See also MPEP 2173.05(e). Here, the telematics device embedded in a customer vehicle provides a proper antecedent basis for subsequent references to “the telematics device” as recited in claims 37 and 38. A careful reading of the claims

reveals that no other telematics device is recited in the claims that could possibly provide a reasonable antecedent basis for the telematics device or give rise to ambiguity. Therefore, it is clear that the scope of claims 37 and 38 would be reasonably ascertainable by those skilled in the art

Furthermore, the Office Action is wrong in stating that dependent claims 37 and 38 fail to further limit independent claim 34. As acknowledged subsequently in the Office Action, claim 37 recites an FM subcarrier network and claim 38 recites an emergency 911 service, which recitations clearly serve to further limit independent claim 34.

Therefore, for at least these reasons, claims 34-40 the objections to claims 34-40 should be withdrawn..

VIII.
CLAIMS APPENDIX
37 C.F.R. 41.37(c)(1)(viii)

34. A method of providing an emergency contact information of a customer using a telematics device embedded in a customer vehicle during an emergency associated with the customer vehicle, the method comprising:

accessing the telematics device embedded in the customer vehicle during the emergency associated with the customer vehicle;

establishing a communication link between the telematics device and a virtual garage, wherein the virtual garage comprises at least one server on the Internet and wherein the virtual garage stores the emergency contact information of the customer;

retrieving the emergency contact information of the customer from the virtual garage using the telematics device;

transmitting the emergency contact information of the customer to a Public Service Answering Point, wherein the emergency contact information is transmitted from the telematics device embedded in the customer vehicle to the Public Service Answering point.

35. The method of claim 34, wherein the communication link comprises the Internet.

36. The method of claim 34, wherein the communication link is a wireless connection.

37. The method of claim 34, wherein the emergency contact information is retrieved from the virtual garage to the telematics device using an FM subcarrier network.

38. The method of claim 34 further comprising requesting an emergency 911 service to the Public Service Answering Point using the telematics device.

39. The method of claim 34 wherein the emergency associated with the customer vehicle comprises a vehicle collision.

40. The method of claim 34, wherein the Public Service Answering Point comprises an emergency medical service vehicle.

IX.

EVIDENCE APPENDIX

37 C.F.R. 41.37(c)(1)(viii)

No Evidence is presented with this Brief.

X.

RELATED PROCEEDINGS APPENDIX

37 C.F.R. 41.37(c)(1)(viii)

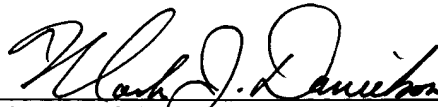
No related proceedings are currently in existence.

If any issues remain which the Examiner feels may be resolved through a telephone interview, s/he is kindly requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,
PILLSBURY WINTHROP SHAW PITTMAN LLP

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